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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/925,938	Applicant(s) MCCABE, RON	
	Examiner Vivek D. Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/20/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-25 and 38-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38, 42, 45 and 46 is/are allowed.
- 6) ☒ Claim(s) 1, 3-25, 39-41, 43, 44 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-25 and 38-47 have been examined in this application. This Final Office Action is in response to the "Remarks" and "Amendment" filed on February 20, 2007.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 39, 41, 43, 44 and the claims depending upon these claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 39, 41, 43 and 44, the term "dynamically" renders these claims indefinite. It is not clear exactly how "dynamically" modifies the step of "adjusting the insurance premium in response to the data change rate as the data change rate changes during a coverage period of the insurance." For the purposes of examination, this step will be interpreted as a step adjusting the insurance premium.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of "Data Security Harmed by Blissful Ignorance" published in Insurance Accountant on April 12, 1999 (Page 1; Volume 1, Number 11) (This reference will be hereinafter referred to simply as "Insurance Accountant") and in further view of US Patent Number 5,855,005 to Schuler and in even further view of Official Notice.

(A) As per claim 1, Crawford in view of Insurance Accountant teach a method of employing a technical protection service pursuant to the issuance or maintenance of a data/presence insurance policy, the method to be performed by an entity desiring coverage by the policy, the method comprising:

employing a technical protection service, the technical protection service protecting at least one of data of the entity and a presence of the entity (Crawford: Col. 14, Ln. 40-44).

Crawford does not teach the following steps which are taught by Insurance Accountant:

obtaining the data /presence insurance by providing evidence of existence of the technical protection service (Note: In Insurance Accountant the insured must provide the insurance company with evidence of the capabilities of the technical protection service prior to the insurance of the insurance policy) (Insurance Accountant: Page 2, Paragraphs 1 and 6-8); and

memorializing a contract for the data/presence insurance (Insurance Accountant: Page 2., Paragraph 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Crawford with the aforementioned teachings from Insurance Accountant with the motivation of an entity of having a means of receiving

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compensation if they incurred a loss of data through a security breach in their systems, as mentioned in Insurance Accountant (Page 2, Paragraph 14).

The above mentioned prior art references do not teach the following which are taught by Schuler (Col. 1, Ln. 15-39):

reporting the performance of the technical protection service to the insurer during performance of the contract for the data/presence insurance and adjusting the premium for data/presence insurance coverage in response to an actual result of the technical protection service after contracting for data/presence insurance.

At the time of the invention it would have been obvious to have modified the above mentioned teachings with this aforementioned teaching from Schuler with the motivation of having a more enhanced means of determining the appropriate premium to charge an insured as recited in Schuler.

The aforementioned teachings do not teach that the reporting step takes place repeatedly, however, the Examiner takes Official Notice that this step is well known in the insurance industry. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the aforementioned teachings with this feature in order to have a more accurate means of estimating potential claims by their insured subjects.

(B) As per claim 2, the combined method of Crawford in view of Insurance Accountant comprises the step of reporting to the insurer on the status of the technical protection service (Insurance Accountant: Page 2, Paragraph 8). The motivation for making this modification to the teachings of Crawford is the same as set forth in the rejection of Claim 1, above.

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At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Crawford with the aforementioned teachings from Insurance Accountant with the motivation of an entity of having a means of receiving compensation if they incurred a loss of data through a security breach in their systems, as mentioned in Insurance Accountant (Page 2, Paragraph 14).

The above mentioned prior art references do not teach the following which are taught by Schuler (Col. 1, Ln. 15-39):

Periodically reporting performance of the technical protection service to an insurer providing the data/presence insurance during performance of the contract for the data/presence insurance and adjusting the premium for data/presence insurance coverage in response to an actual result of the technical protection service after contracting for data/presence insurance. At the time of the invention it would have been obvious to have modified the above mentioned teachings with this aforementioned teaching from Schuler with the motivation of having a more enhanced means of determining the appropriate premium to charge an insured as recited in Schuler.

(C) As per claim 3, the combined method of Crawford in view of Insurance Accountant teaches a step of establishing a technical protection service which further comprises establishing a data mirroring service (Crawford: Col. 14, Ln. 45-61).

(D) As per claim 4, the combined method of Crawford in view of Insurance Accountant teaches a step of establishing a technical protection service which further comprises establishing a virus detection service (Crawford: Col. 14, Ln. 45-61).

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(E) As per claim 5, the combined method of Crawford in view of Insurance Accountant teaches a step of creating a snapshot of the data of the entity; and if a virus is detected, rolling back the data to a point in time before the virus was detected using the snapshot (Crawford: Col. 14, Ln. 45-61). (Note: The examiner takes the position that the archival services taught in Crawford allow a user to roll back the data to a given point in time.)

(F) As per claims 6 and 7, the combined method of Crawford in view of Insurance Accountant teaches obtaining the data/presence insurance and this step further comprises obtaining data (or presence) insurance (Crawford: Col. 2, Ln. 5-21 and Col. 14, Ln. 62-Col. 15, Ln. 5) and Insurance Accountant (Paragraph 14). The motivation for making this modification to the teachings of Crawford is the same as set forth in the rejection of Claim 1, above.

(G) As per claim 8, this claim repeats features previously addressed in the rejections of claims 1-2 and is rejected on the same basis.

(H) As per claim 9, this claim repeats features previously addressed in the rejection of claim 3 and is rejected on the same basis.

(I) As per claim 10, this claim repeats features previously addressed in the rejection of claim 4 and is rejected on the same basis.

(J) As per claim 11, this claim repeats features previously addressed in the rejection of claim 5 and is rejected on the same basis.

(K) As per claims 12-13, these claims repeat features previously addressed in the rejections of claims 6-7, above, respectively and are rejected on the same basis.

(L) As per claims 14 and 47, the combined method of Crawford in view of Insurance Accountant teaches a method for providing data/presence insurance coverage to an entity in

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view of a technical service protection to be employed by or provided to the entity, the method to be performed by an insurer, the method comprising the steps of:

Crawford teaches the use of a technical protection service (Crawford: Col. 14, Ln. 40-44) but does not teach the following steps which are taught by Insurance Accountant:

calculating a premium for the data/presence insurance coverage, the premium calculation depending on an expected result of the technical protection service (Insurance Accountant: Page 2, Paragraphs 1, 6-8 and 14) (Note: Insurance Accountant requires that an entity employ a network security/protection device before an insurance policy is ensured so the premium charged in Insurance Accountant necessarily takes into account of the expected result of the network security/protection device); and

contracting with the insured entity for the data/presence insurance coverage in view of technical protection service, the contracting step memorialized in an agreement whose named parties or intended beneficiaries include the insurer and the insured entity (Insurance Accountant: Page 2, Paragraph 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Crawford with the aforementioned teachings from Insurance Accountant with the motivation of an entity of having a means of receiving compensation if they incurred a loss of data through a security breach in their systems, as mentioned in Insurance Accountant (Page 2, Paragraph 14).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Crawford with the aforementioned teachings from Insurance Accountant with the motivation of an entity of having a means of receiving

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compensation if they incurred a loss of data through a security breach in their systems, as mentioned in Insurance Accountant (Page 2, Paragraph 14).

The above mentioned prior art references do not teach the following which are taught by Schuler (Col. 1, Ln. 15-39):

Periodically reporting performance of the technical protection service to an insurer providing the data/presence insurance during performance of the contract for the data/presence insurance and repeatedly adjusting the premium for data/presence insurance coverage in response to an actual result of the technical protection service after contracting for data/presence insurance and during the performance of the contract for the data/presence insurance. At the time of the invention it would have been obvious to have modified the above mentioned teachings with this aforementioned teaching from Schuler with the motivation of having a more enhanced means of determining the appropriate premium to charge an insured as recited in Schuler.

The aforementioned teachings do not teach that the reporting step takes place repeatedly, however, the Examiner takes Official Notice that this step is well known in the insurance industry. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the aforementioned teachings with this feature in order to have a more accurate means of estimating potential claims by their insured subjects.

As per claim 47, Schuler teaches the step of monitoring the actual result of the technical protection service over a current time period within a term of the data / presence insurance; wherein:

adjusting the premium for the data / presence insurance coverage in response to the actual result of the technical protection service further comprises adjusting the premium for the data /

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presence insurance coverage for a subsequent time period within the term of the data / presence insurance in response to the actual result of the technical protection service during the current time period; and

the current time period and the subsequent time period are mutually exclusive and are each less than one day (Schuler: Col. 2, Ln. 27-32 and Col. 4, Ln. 43-47). The motivation for making this modification to the teachings of Crawford is the same as that set forth in the rejection of Claim 14, which is set forth above.

(M) As per claim 15, in the combined method of Crawford in view of Insurance Accountant the contracting step memorializes an agreement whose named parties or intended beneficiaries include a technical services provider, the insurer, and the insured entity, and wherein the technical services provider provides the technical protection service to the insured entity under the agreement (Crawford: Col. 15, Ln. 2-5) and Insurance Accountant (Page 2, Paragraphs 1, 6-9 and 14). The motivation for making this modification to the teachings of Crawford is the same as set forth in the rejection of Claim 14, above.

(N) As per claim 16, in the combined method of Crawford in view of Insurance Accountant the technical services provider reports to the insurer on the status of the technical protection service (Crawford: Figure 6B, Col. 25, Ln. 18-23) and Insurance Accountant (Page 2, Paragraphs 1, 6-9 and 14). The motivation for making this modification to the teachings of Crawford is the same as set forth in the rejection of Claim 14, above.

(O) As per claim 17, in the combined method of Crawford in view of Insurance Accountant the calculating step depends on the expected result of a data mirroring service as the technical protection service (Crawford: Col. 14, Ln. 45-61) and Insurance Accountant (Page 2, Paragraphs

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1, 6-9 and 14). The motivation for making this modification to the teachings of Crawford is the same as set forth in the rejection of Claim 14, above.

(P) As per claims 22-23, in the combined method of Crawford in view of Insurance Accountant the contracting step memorialized data insurance and presence insurance in the agreement (Crawford: Col. 2, Ln. 5-21 and Col. 14, Ln. 62-Col. 15, Ln. 5) and Insurance Accountant (Page 2: Paragraph 9 and Paragraph 14). The motivation for making this modification to the teachings of Crawford is the same as set forth in the rejection of Claim 14, above.

5. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Insurance Accountant in view of Schuler and in further view of Cheeseman.

(A) As per claims 18-21, claims repeat features previously addressed in the rejection of claims 14, above, respectively and are rejected on the same basis. The further claimed factors used in calculating insurance premiums are taught in risk mitigation factors which are taught in "Disaster Protection: Insurers Will Rescue Only What You Protect" by Ian Cheeseman (hereinafter referred to as Cheeseman) (Abstract).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of the above mentioned references with the teachings from Cheeseman with the motivation of having a means to reduce a client's premium in response to their adoption of disaster prevention methods.

Response to Arguments

7. Applicant's arguments filed on February 20, 2007 with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

Allowable Subject Matter

8. Claims 38, 42, 45-46 are allowed over the prior art of record.

The prior art of record does not teach a method of providing insurance against data loss wherein there is a step of determining an exposure period, the exposure period based on a time period between a time a data change occurs on the local data volume and a time the data change occurs on the remote data volume.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

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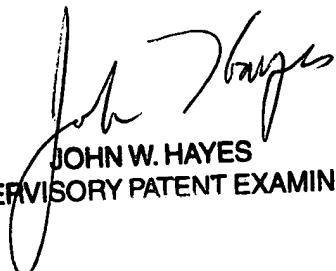
If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,


Vivek Koppikar

3/28/2007


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER